

REMARKS/ARGUMENTS

These remarks are submitted in response to the Office Action dated February 17, 2009 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 14-1437.

Claim Rejections – 35 USC § 103

Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2001/0014868 to Herz (hereinafter Herz) in view of U.S. Published Patent Application 2001/0039514 to Barenbaum (hereinafter Barenbaum).

Although Applicants respectfully disagree with the rejections, Applicants have amended Claim 1 in an effort to even more clearly define the present invention and to facilitate prosecution of the instant applications. Claims 25-29 have been added. As discussed herein, the claim amendment and added claims are fully supported by the original o new matter has been introduced by the claim amendments.

Applicants' Invention Predates Barenbaum

Applicants respectfully submit that Applicants' invention predates the April 4, 2000 effective date of Barenbaum. Declarations and other supporting evidence for establishing conception of the claimed subject matter at least as early as March 20, 2000 and diligence from prior to the effective date Barenbaum to the date that the instant Application was filed have been submitted with the response dated November 6, 2006.

It was asserted on page 11 of the Office Action dated March 21, 2007 that Applicant's Invention Disclosure created on 03/20/2000 simply describes the concept of tracking the expiration date and/or life expectancy of items purchased by consumers and notifying the consumers with advertisements that replenishment was needed based on items previously purchased expiring or exceeding their useful life. Targeting consumers

based upon the expiration date or products exceeding their useful life is not the same as targeting advertisements to consumers based upon previously purchased items becoming obsolete because a new or alternate version of the at least one merchant-specified product is expected to be introduced within a predetermined time period, as recited in Applicant's claim 1.

However, it is noted that it is described on page 11, lines 20-21 of the specification: "Product expiration information also can correspond to the life cycle of a product, which typically does not wear out, but rather becomes obsolete or otherwise undesirable." Therefore, the product expiration information or useful life information is related to products becoming obsolete.

It was asserted on page 12 of the Office Action dated March 21, 2007 that Applicant's affidavit is defective in proving diligence because the Applicant must account for the entire period during which diligence is required, which in the Applicant's case is from March 20, 2000 to February 16, 2001, which is almost 11 month. The Applicant simply mentioning in his affidavit page 2, section 6 that he conceived the present claimed invention from at least as early as March 20, 2000, and exercised due diligence from that date to February 21, 2001 is not enough proof that the Applicant was diligent.

First, it is noted that the period during which diligence is required should be from April 3, 2000 (just prior to the effective date April 4, 2000 of Barenbaum) to February 16, 2001 (filing date of the instant application). Second, the length of the period during which diligence is required should not be an indication of lacking of diligence. Third, besides the declarations, Applicants have also submitted the following supporting evidence:

- A letter dated April 14, 2000, in which IBM instructed outside counsel to prepare and file an application for the invention described in the Invention Disclosure. Outside counsel prepared the Application consistent with long-established professional practices. According to these established practices,

outside counsel prepares cases on a first-in, first-out basis unless a particular case is associated with a bar date, in which event the case is granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case. According to MPEP 2138.06, "Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient."

- A letter dated January 5, 2001 from the outside counsel attaching the draft application.
- An e-mail letter dated January 29, 2001 from one of the inventors with comments and questions after reviewing the draft application. Outside counsel revised the draft application consistent with Applicants' comments and filed the Application on February 16, 2001.

Therefore, Applicants believe that Applicants conceived the present claimed invention prior to the effective date April 4, 2000 of Barenbaum and exercised due diligence from a date just before the effective date of Barenbaum until the filing of the instant application on February 21, 2001. Barenbaum is thus not available as prior art reference and all rejections in connection with Barenbaum are moot.

The Claims Define Over The Prior Art

As already discussed in the previous response, the present invention has the ability to handle a pending or impending inventory crisis, such as when the merchant does not have room for a delivery, namely an order that is already on its way to the merchant (see Specification, page 9, lines 15-16 and page 17, lines 21-22, "... a merchant receiving a shipment of goods, ..."). Herz and Barenbaum address inventory that the merchant already has ordered and, in the case of paragraph [0311] of Herz cited by the Examiner

on page 9 of the Office Action, is going to order. None of the references addresses shipments that are on their way to the merchant.

Paragraph [0311] of Herz does not solve the problem of a truck backing up to a warehouse to make a delivery for which there is no room. Rather, paragraph [0311] of Herz tries to avoid that situation in the first place by using heuristics to predict what should be ordered and when to order. But, what if the prediction is wrong? Paragraphs [0308]–[0312] of Herz describe modeling a collection of shoppers for a given store and using that information to order "just-in-time" deliveries. Further, paragraph [0313] of Herz applies the methodology to "new retail outlets." But, suppose something happens to make the model err. For example, suppose there is a sudden climate change and consumers are not buying what Herz has ordered. Now, with the order on its way, Herz has an impending crisis. In fact, considering paragraph [0313] of Heerz, the problem can be multiplied by each new store. The present invention can solve the problem while Herz and Barenbaum cannot. In fact, Herz and Barenbaum cannot even recognize the problem until it is too late.

Therefore, neither Herz nor Barenbaum nor a combination thereof discloses detecting products to be promoted based on the detected business necessity including receiving a shipment of goods, as recited in independent claims of the instant application.

It was asserted in the first paragraph on page 8 of the Office Action that Herz teaches recommending upgrades to a computer system because demands and performance problems (i.e. obsolete) due to the life cycle of the product (see paragraph 246).

As already provided in the previous response, the following example clearly illustrates the difference between "obsolete" and "upgrade": assuming there are square pegs and square holes, when the next version of the holes are round, the square pegs are obsolete. They cannot be upgraded. They have to be replaced even though they are perfectly fine square pegs.

It is stated on page 11, lines 20-21 of the Specification of the instant application: "Product expiration information also can correspond to the life cycle of a product, which typically does not wear out, but rather becomes obsolete or otherwise undesirable." It is clear from this sentence that the life cycle of a product can make the product obsolete or otherwise undesirable. Therefore, "undesirable" is not the definition of "obsolete," but rather an alternative consequence of the product expiration information. The fashion example given on page 12, lines 1-6 of the Specification of the instant application is not an example of an "obsolete" product, but rather an example of "undesirable" product. The same analysis applies to the examples provided in paragraph [0018] of Barenbaum. The summer dresses are no longer desirable at the end of the summer season, but they are still useful and thus not "obsolete." Similarly, in Herz the upgrades to a computer system do not make the previous computer system "obsolete," but only "undesirable."

As also already discussed in a previous response, there is a clear difference between expiration and obsolescence. Many products have expiration dates and, when the date is reached, they can be replaced with the same but newer product. For example, an expired license can be renewed. But, becoming obsolete is different. For example, let's say you have a cover for an item of certain dimensions and the item is worn out. When you go to buy a replacement for the item, you find that one in those dimensions is no longer made. The replacement item has dimensions such that your cover won't fit it. The cover is then rendered obsolete, not expired. If you buy the replacement item, you need a new cover, too, but this is because your cover has become obsolete, not expired.

It was asserted in the second paragraph on page 8 of the Office Action that Herz teaches obtaining demographic information about shoppers (see paragraph 31) and using the information to target offers to the shoppers' mailing addresses or electronic mails (see paragraph 51).

However, it is noted that the present invention concerns determining the appropriate communication mode for delivering the promotional material based upon communication mode information uniquely corresponding to a particular consumer. In

contrast, Herz concerns determining which shoppers are to be targeted as a group based on demographic information.

Accordingly, the cited references, alone or in combination, fail to disclose or suggest each and every element of Claim 1, as amended. Applicants therefore respectfully submit that amended Claim 1 defines over the prior art. Furthermore, as each of the remaining claims depends from Claim 1 while reciting additional features, Applicants further respectfully submit that the remaining claims likewise define over the prior art.

Applicants thus respectfully request that the claim rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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